

Application No.: 10/719,164  
Response dated: December 27, 2006  
Reply to Office Action dated: July 28, 2006

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#### REMARKS

In an Office Action mailed July 28, 2006, the Examiner objected to the specification, accepted the drawings, and rejected the pending claim under 35 U.S.C. § 102(b) as failing to patentably distinguish over Huxley *et al.*, for reasons of record. The Examiner maintained objections to the disclosure under 37 C.F.R. § 1.163(a) and under 35 U.S.C. § 112, first paragraph. Applicants respectfully request reconsideration in view of the following comments.

Having reviewed the prosecution history of this application, the undersigned believes that the Examiner has misinterpreted certain comments by applicant in prior responses and wishes here to correct any misunderstandings about applicants' view of the relationship between "September Sun" and the species *Alnus maritima*. Applicants also submit with this response an Information Disclosure Statement citing three publications by the inventors. Of particular interest is a 2002 paper (Castanea 67(4): 380-401, December 2002) which describes new subspecies of *Alnus maritima*, including subspecies *oklahomensis*, from which September Sun derives. This paper provides context for the indicated distinctions from the species and its subspecies, as currently understood in the art, and provides characteristic attributes of the various subspecies. It is believed that upon consideration of the complete characterizations of the subspecies in the 2002 castanea paper, the Examiner will appreciate that the distinctions disclosed in the application are, in fact, distinctions from the species in general. The Examiner speculates that it may be the other plants in the trial that are distinctive from the species in general, but this is not the case.

Turning to the office action, applicants reiterate that they have already provided a complete description of those attributes of September Sun that are statistically distinct from known members of the species, including relevant color designations. As to the Examiner's suggestion that applicants merely describe this species in general rather than the claimed plant, applicants here attempt to clarify the prior response.

Applicants did not admit on page 5 of the prior response that the botanical description is limited to a recitation of the species in general. Applicants intended to make clear that a portion of the specification does describe the species in general, but that those attributes characteristic of September Sun are provided separately and are so identified. Applicants' statement that "none of these descriptions are intended to be distinctive of this variety of plant from the species or subspecies in general" was a reference to those portions of the specification relating to the species in general. However, applicants also distinguished those

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descriptions from those of the cultivar sought to be patented in paragraph 24. As was noted before, "what the applicants have not provided here, are descriptions of the species as a whole which would not add to the descriptive attributes of the patent on this particular cultivar."

On page 7 of the office action, the Examiner again relies on applicants' alleged indication that the claimed plant is no different from the species in general. For the reasons noted above, applicants strenuously object to this characterization of September Sun. In summary, applicants maintain that their presentation of all relevant characteristics that distinguish September Sun from the species are presented and that no additional characterization is warranted, or indeed, is available. To reiterate all other attributes of September Sun that do not differ from the species in general would merely place an undue and unrequired burden on applicants.

Reconsideration of the rejection and the objections is respectfully requested. Applicants also respectfully request an opportunity to speak directly with the Examiner by phone to discuss the further progress of this application. Applicants' full statutory 6 month period for response ends on January 28, 2007. The undersigned hopes that the Examiner is available to discuss the matter before that date.

Fees

A petition for a two-month extension of time accompanies this response so the response will be deemed to have been timely filed. Please charge the extension fee due to Deposit Account No. 17-0055.

Apart from the extension of time, no other fee is believed due. However, should any fee be due in this or any subsequent response, please consider this to be a request to charge the fee to Deposit Account No. 17-0055. Likewise, should any other extension of time be due, please consider this to be a petition for the appropriate extension of time and a request to charge the fee for the extension of time to the same Deposit Account.

Respectfully submitted,



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